

REPLY

Serial No. 09/954,586
Atty. Docket No. GP116-03.UT

Remarks

Claims 164-264 are presently pending in the subject application

Reconsideration and allowance are respectfully requested in view of the above amendments and the following remarks.

Claims 1, 11, 12, 14-23, 29, 37-40, 50-53, 59, 60, 84, 94-99, 114-116, 121-126, 133-144 and 151-163 are canceled herein without prejudice to prosecution of the subject matter of these claims in this or a future continuing application.

Claims 164-264 are newly added and find support in the application as filed. Applicants submit that no new matter is being introduced by these amendments.

During a telephone interview with the undersigned on August 1, 2005, the Examiner granted Applicants permission to pursue claims based on a previously non-elected set of first and second amplification oligonucleotides, where the first amplification oligonucleotide has a target sequence selected from the group consisting of SEQ ID Nos. 46, 52, 58 and 64 and the second amplification oligonucleotide has a target sequence selected from the group consisting of SEQ ID Nos. 47, 53, 59 and 65.

Rejections Under 35 U.S.C. § 103

Claims 1, 14, 19-23, 29, 37-40, 50-53, 59, 60, 84, 94-99, 114-116, 121-126, 133-144 and 151-159 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Zhu *et al.* (*J. Infect. Dis.*, 177:1443-1446(1998)) in view of Williams *et al.* (U.S. Pat. No. 6,146,855) and Xiao *et al.* (*Appl. Environ. Microbiol.*, 65(8):3386-3391 (1999)) in view of Hogan (U.S. Pat. No. 5,595,874). Applicants respectfully traverse this rejection for the reasons that follow.

As noted by Applicants' representative during the August 1st interview with the Examiner, Example 6 of the application provides a comparison of two sets of amplification oligonucleotides, the results of which are set forth in Table 2. These results show that, for the experiment of this example, a primer pair

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having the template-specific base sequences of SEQ ID Nos. 46 and 59 ("Primer Set One") significantly outperformed a primer pair having the template-specific base sequences of SEQ ID Nos. 45 and 59 ("Primer Set Two"). As the relative light unit ("RLU") values of this experiment demonstrate, Primer Set One was capable of sensitively detecting a smaller concentration of ribosomal RNA than is normally present in a single *C. parvum* oocyst, while Primer Set Two did not amplify the target nucleic acid sequence (as defined in Example 2 of the application) at any of the tested target concentrations. Thus, the data shows that Primer Set One worked unexpectedly well at amplifying the *C. parvum* target nucleic acid sequence. Accordingly, withdrawal of this rejection is respectfully requested in view of Applicants' evidence of the non-obviousness of the claimed set of amplification oligonucleotides.

Claims 11, 12 and 15-18 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Zhu *et al.* (*J. Infect. Dis.*, 177:1443-1446(1998)) in view of Williams *et al.* (U.S. Pat. No. 6,146,855) and Xiao *et al.* (*Appl. Environ. Microbiol.*, 65(8):3386-3391 (1999)) in view of Hogan (U.S. Pat. No. 5,595,874) as applied to claims 1, 14, 19-23, 29, 37-40, 50-53, 59, 60, 84, 94-99, 114-116, 121-126, 133-144 and 151-159, and further in view of Becker *et al.* (U.S. Pat. No. 6,361,945). Applicants submit that the teachings of Becker do not overcome the deficiencies noted above in the teachings of Zhu, Williams and Xiao when combined with the teachings of Hogan. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections Under 35 U.S.C. § 112

Claims 1, 11, 12, 14-23, 29, 37-40, 50-53, 59, 60, 84, 94-99, 114-116, 121-126, 133-144 and 151-163 stand rejected by the Examiner under 35 U.S.C. § 112, second paragraph, for failing to satisfy the written description requirement. Applicants submit that these rejections are rendered moot by the newly submitted claims herein. Accordingly, withdrawal of this rejection is respectfully requested.

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Claims 1, 11, 12, 14-23, 29, 37-40, 50-53, 59, 60, 84, 94-99, 114-116, 121-126, 133-144 and 151-163 stand rejected by the Examiner under 35 U.S.C. § 112, first paragraph, as being indefinite. Applicants submit that these rejections are rendered moot by the newly submitted claims herein. Accordingly, withdrawal of this rejection is respectfully requested.

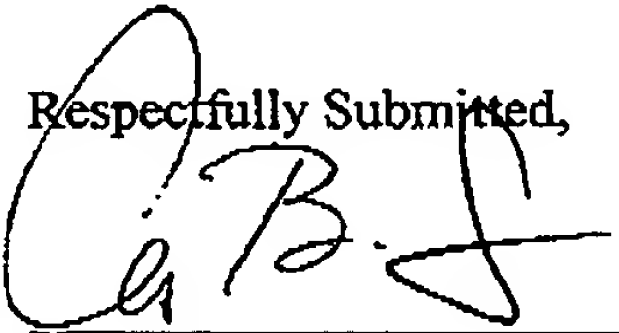
Applicants submit that the subject application is in condition for allowance and early notice to that effect is earnestly solicited.

Please charge any fees due in connection with this Reply, including the fee for a two-month extension of time, to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

Certificate of Transmission

I hereby certify that this correspondence (and any referred to as attached) is being sent by facsimile to 571-273-8300 on the date indicated below to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: August 9, 2005

Respectfully Submitted,

By: _____

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